REMARKS

Applicant intends this response to be a complete response to the Examiner's **6 July 2006** Non-Final Office Action. Applicant has labeled the paragraphs in his response to correspond to the paragraph labeling in the Office Action for the convenience of the Examiner.

DETAILED ACTION

Claim Rejections - 35 USC § 112

2. **Claims 2-9 and 39** stand rejected under 35 U.S.C. 112, first paragraph.

The Examiner contends as follows:

> While being enabling for specific materials (specific aqueous components, specific, non-aqueous fluid, specific solid material) and extraction fluids, does not reasonably provide enablement for any non-specified extraction fluid, non-specified materials and non-specified products. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with these claims.

Applicants have amended claim 39 to list the materials that can be treated by the present method. This list is directly from the specification. As the specification gave detailed examples of oil laden solids, used oil, and drilling fluids, the list of material is fully consistent with the scope of the example. The patent statutes do not require as experiment for each and every possible material that can be treated. The examples set forth are fully consistent with treating the listed materials.

Because the specification is clearly enabling for the listed treated materials, Applicants respectfully request withdrawal of this 112, 1st paragraph rejection.

3. **Claim 8** stands rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement.

The Examiner contends as follows:

> The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The claim requires the material to be treated be a hydrocarbon fuel. This claim depends on claim 39, which, as amended, requires the material to comprise water, water-soluble aqueous components and solid material in addition to a non-aqueous fluid. The conventional hydrocarbon fuels, such as gasoline do not comprise the components recited by claim 39. It means that claim 8 is not enabled or not enabled for entire scope of the term "hydrocarbon fluid".

Applicants wholly disagree with the Examiner's mistaken belief that hydrocarbon fuels do not contain water and water soluble components. A quick review of gasoline specs will clearly

show that water is always present as are many water soluble components (e.g., components to increase combustion, clean injectors, stabilizers, etc.). Simply because a given material contains only small amount of water or water soluble components is not material to the method of this invention. The method works regardless of the exact material being fed. Moreover, fuels often also have traces of solids. Again, the exact amount of water insolubles, water, water solubles and solids is not material. The method works and produces three material. Each treated material will include a different mix of material surely, but again that is wholly immaterial.

Because the patent statutes do not require that the material produce large amounts of each output material, this 112, 1st paragraph rejection is without merit and Applicants, respectfully, request withdrawal of this rejection.

Double Patenting

5. **Claims 2-9 and 39** are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 2-4 and 25-30 of copending Application No. 10/470,965. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

The Examiner contends as follows:

> The applicants amended the claims. The claims as amended are the same as in the copending application except for an additional step required by the claims of the copending application. The claims of the copending application comprise an additional step, which requires: 'transferring thermal energy from process steps the produce heat to process steps that require heat to improve the overall power requirements of the process." It is not exactly clear what is required by this step, since it is not clear how can energy be transferred between process steps, what is referenced as "process steps the produce heat" and "process steps that require heat". Thereby, the claims would also further rejected under doctrine of obvious double patenting. However, at the best examiner's understanding of what is claimed the additional step recited by the co-pending application is inherent because the thermal energy would be at least to some extend transferred with different fluids from one part of the extraction vessel to another and from one extraction vessel to another.
> 6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., In re Berg, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ

645 (Fed. Cir. 1985); In re Van Omum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. **Claims 2-9 and 39** stand provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 2-4 and 25-30 of copending Application No. 10/470,965.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the scope of the claims of the co-pending application is inside of the scope of the claims of the instant application and because it would have been obvious to an ordinary artisan at the time the invention was made to conserve and utilize energy in order to reduce operation cost.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Applicants is filing a terminal disclaimer with this response. Applicants, therefore, respectfully request withdrawal of this rejection.

Response to Arguments

8. Applicant's arguments filed 04/10/06 have been fully considered but they are not persuasive.

The applicants have amended the claims and argue that the previously presented rejections are not proper.

While, most of the deficiencies of the claims has been obviated by the amendment, the rejection of claims 2-9 and 39 made under 35 USC 112(1) as not enabled for entire scope of the claims has not been obviated the claims still recite non-specified extraction fluid, non-specified materials and non-specified products.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a).

Having fully responded to the Examiner's Non-Final Office Action, Applicant respectfully urges that is application be passed onto allowance.

If it would be of assistance in resolving any issues in this application, the Examiner is kindly invited to contact applicant's attorney Robert W. Strozier at 713.977.7000

Date: **September 14, 2006**

Respectfully submitted,

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